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10/613,831	07/03/2003	Wang Wei Min	03-108	6808

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EXAMINER

MAYES, DIONNE WALLS

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,831

Applicant(s)

MIN, WANG WEI

Examiner

Dionne Walls Mayes

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Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso (U.S. Patent No. 3,313,308).

Regarding claim 1, Grasso teaches an article for smoking an elongate tobacco product comprising:

(a) a mouthpiece having an inside surface and an outside surface, comprising a first end defining a receptacle therein and a second end comprising an outside surface capable of being grasped in a smoker's mouth and defining an outlet chamber within the mouthpiece (Figures 2 and 3); and

(b) a holder, the holder being removably inserted into the receptacle (Figure 2), the holder comprising,

i) a first section disposed at an end of the holder defining an inside chamber capable of holding the elongate tobacco product in place and allowing a volume for collection of combustion products therein, the first section having an outside surface with a diameter too large to fit into the receptacle in the mouth piece (Figure 3),

ii) a second section in series with the first section and having an inside and an outside surface, the second section contoured to fit into the receptacle in the mouthpiece and defining a continuation of the inside chamber (Figure 3 reference number 18),

iii) a first annular support (Figure 3, reference number 48) and a second annular support (Figure 3, reference number 36) on the outside surface of the second section, each annular support being capable of holding a resilient ring thereon,

iv) an annular baffle on the outside of the second section between the first annular support and the second annular support (Figures 2 and 3, reference number 26; column 2, lines 20-21), and

v) one resilient ring supported on one of the annular supports (Figures 2 and 3), wherein the mouthpiece and the holder are contoured such that when the holder is inserted into the mouthpiece the resilient ring is in contact with the inner surface of the mouthpiece forming a sealed chamber in the annular space between the resilient ring and one of the annular supports between the outside surface of the second section and the inside surface of the mouthpiece (Figure 3; 63-65), and wherein the holder defines at least one restricted passage from the inside chamber to the sealed chamber, said at least one restricted passage being directed towards the inside surface of the mouthpiece between the two annular supports, and wherein the holder further defines an exit passage having at least

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one inlet between the baffle and the second annular support and an exit into the outlet chamber of the mouthpiece (Figure 3; column 3, lines 39-40).

Grasso fails to teach two resilient rings, one resilient ring supported on each annular support. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used two resilient rings one on each annular support as a means of reinforcing the integrity of the sealed chamber. Accordingly, claim 1 is rejected.

Regarding claim 2, Grasso teaches that the holder further comprises a barrier in series with the second inside chamber such that combustion products can only pass between the inside chamber and the outlet chamber through a path through the restricted passage, the sealed chamber and the exit passage in sequence (Figure 3; column 3, lines 39-40 and lines 44-46). Accordingly, claim 2 is rejected.

Regarding claim 3-5, Grasso teaches the holder is for cigarettes and the like (claim 1, line 1). Grasso does not specifically teach the holder is for cigarettes of the type without an integral filter, cigarettes with an integral filter, or for cigars. However, because Grasso fails to limit his teaching to any particular type of cigarette or tobacco product, it would have been obvious to one of ordinary skill in the art at the time of the invention that Grasso's teaching could have been applied to a cigarette with an integral filter, a cigarette without an integral filter, or to a cigar. Accordingly, claims 3-6 are rejected.

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Regarding claim 8, Grasso teaches the holder has symmetry about a central plane, wherein any cross section perpendicular to the central plane is circular (Figure 3; column 2, lines 7-12; column 2, lines 55-56). Accordingly, claim 8 is rejected.

Regarding claim 9, Grasso teaches that at least one restricted passage is perpendicular to the central plane of symmetry whereby combustion products are made to change direction by approximately 90 degrees in passing between the second inside chamber and the sealed chamber (column 3, lines 20-28). Accordingly, claim 9 is rejected.

Regarding claim 10, Grasso teaches that at least one restricted passage comprises two diametrically opposed passages through the holder (Figure 3). Accordingly, claim 10 is rejected.

Regarding claim 11, Grasso teaches that the exit passage causes a change in direction, whereby combustion products are made to change direction by approximately 90 degrees in passing between the sealed chamber and the outlet chamber (Figure 3). Accordingly, claim 11 is rejected.

Regarding claim 12, Grasso teaches that at least one inlet to the exit passage comprises two diametrically opposed passages through the holder (Figure 3). Accordingly, claim 12 is rejected.

Regarding claim 14, Grasso fails to teach a process for smoking an elongate tobacco product so as to reduce the amount of tarry materials consumed. However, Grasso does teach an article for smoking an elongate tobacco product so as to reduce

the amount of tarry materials consumed. The following acts all being obvious to one ordinary skill in the art at the time of the invention during the use of the article:

a) placing the elongate tobacco product in a receptacle of a holder, a portion of the holder behind the receptacle being removably inserted into a mouthpiece (column 3, lines 57-58);

b) lighting the elongate tobacco product and applying suction to the holder through the mouthpiece such that combustion products are drawn through the holder (column 3, lines 13-19);

c) passing the combustion products through a restricted passage such that the combustion products accelerate, expand and impinge on a side of the mouthpiece into a single sealed chamber formed in an annular space between the holder and the mouthpiece between two resilient rings each forming a seal between the mouthpiece and the holder (Figure 3);

d) allowing tarry materials to condense within said sealed chamber (column 3, lines 29-32 and 50-51); and

e) drawing the remaining combustion products over a baffle into an outlet passage leading to an exit of the mouthpiece whereto suction is applied (column 3, lines 39-46).

Accordingly, claim 14 is rejected.

Regarding claim 15, Grasso teaches the tarry materials accumulating in the sealed chamber (column 3, lines 29-32 and 50-51). Accordingly, claim 15 is rejected.

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Regarding claim 16, Grasso teaches the act of a person grasping the portion of the holder extending outside of the mouthpiece in one hand and the mouthpiece in another hand, unthreading the mouthpiece from the holder member (column 3, lines 56-59), and cleaning an outer surface of the holder and an inner surface of the mouthpiece (column 3, lines 60-61). Grasso fails to teach pulling the holder out of the mouthpiece. However, it would have been obvious to one of ordinary skill in the art at the time of the invention for the person using the article to remove the holder from the mouthpiece, i.e. by unthreading the two pieces or pulling them apart depending on how the two pieces are connected in order to dismantle the article so that it may be cleaned. Accordingly, claim 16 is rejected.

Regarding claim 17, Grasso teaches replacing the holder in the mouthpiece (column 3, lines 72-73). Accordingly, claim 17 is rejected.

Regarding claim 18, Grasso teaches the article (holder) is for cigarettes and the like. Grasso does not specifically teach the holder is for cigarettes of the type without an integral filter, cigarettes with an integral filter, or for cigars. However, because Grasso fails to limit his teaching to any particular type of cigarette or tobacco product, it would have been obvious to one of ordinary skill in the art at the time of the invention that Grasso's teaching could have been applied to a cigarette with an integral filter, a cigarette without an integral filter, or to a cigar. Accordingly, claim 18 is rejected.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso as applied to claim 1 above, and further in view of Mensik (U.S. Patent No. 4,517,989).

Grasso teaches the mouthpiece comprises a plastic. Grasso fails to teach what

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material the holder comprises. However, Mensik teaches a cigarette holder and mouthpiece molded from plastic (claim 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to take the teaching of Grasso and combine it with the teaching of Mensik to make a cigarette holder and mouthpiece from plastic. Regarding the resilient rings being o-rings, Grasso teaches this (column 2, lines 59-60). Accordingly, claim 6 is rejected.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso as applied to claim 1 above, Mensik as applied in claim 6 above, and further in view of Dailey (U.S. Patent No. 3,434,380) and Taylor et al (U.S. PG Pub. 2003/0047526).

Grasso fails to teach what type of plastic the holder is made of and also fails to teach what type of material the holder comprises. However, Mensik teaches a cigarette holder and mouthpiece molded from plastic (claim 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to take the teaching of Grasso and combine it with the teaching of Mensik to make a cigarette holder and mouthpiece from plastic. Both Grasso and Mensik fail to teach the mouthpiece comprises polystyrene and the holder comprises Acrylonitrile Butadiene Styrene (ABS). However, Dailey teaches a cigarette mouthpiece comprising polystyrene (Figure 1 and column 2, lines 58-62). Taylor teaches that ABS is an injected molded plastic (page 5, para 0066, line 15). As a result, it would have been obvious to one of ordinary skill in the art to take the teachings of Grasso and Mensik and combine them with the teachings of Dailey and Taylor to make an injection molded plastic cigarette holder and mouthpiece out of polystyrene and ABS, respectively. Regarding the resilient rings being o-rings, Grasso

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teaches this (column 2, lines 59-60). Regarding the holder and mouthpiece each being a single piece of injection-molded plastic, this is a matter of design choice. Accordingly, claim 7 is rejected.

5. Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mensik (U.S. Patent No. 4,292,983).

Regarding claim 1, Mensik teaches an article for smoking an elongate tobacco product comprising:

(a) a mouthpiece having an inside surface and an outside surface, comprising a first end defining a receptacle therein and a second end comprising an outside surface capable of being grasped in a smoker's mouth and defining an outlet chamber within the mouthpiece (Figures 1 and 3); and

(b) a holder, the holder being removably inserted into the receptacle (Figure 2), the holder comprising,

i) a first section disposed at an end of the holder defining an inside chamber capable of holding the elongate tobacco product in place and allowing a volume for collection of combustion products therein, the first section having an outside surface with a diameter too large to fit into the receptacle in the mouth piece (Figure 2, reference number 14),

ii) a second section in series with the first section and having an inside and an outside surface, the second section contoured to fit into the receptacle in the mouthpiece and defining a continuation of the inside chamber (Figure 2 reference numbers 12 and 11),

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iii) a first annular support and a second annular support on the outside surface of the second section, each annular support being capable of holding a resilient ring thereon (Figure 1, ends of reference number 11),

iv) an annular baffle on the outside of the second section between the first annular support and the second annular support (Figure 2, reference number 23); and

v) the holder defines at least one restricted passage from the inside chamber to the sealed chamber, said at least one restricted passage being directed towards in the inside surface of the mouthpiece between the two annular supports, and wherein the holder further defines an exit passage having at least one inlet between the baffle and the second annular support and an exit into the outlet chamber of the mouthpiece.

Mensik fails to teach two resilient rings, one resilient ring supported on each annular support, wherein the mouthpiece and the holder are contoured such that when the holder is inserted into the mouthpiece the two resilient ring are in snug contact with the inner surface of the mouthpiece forming a sealed chamber between them in the annular space between the outside surface of the second section and the inside surface of the mouthpiece. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used two resilient rings one on each annular support as a means of reinforcing the integrity of the sealed chamber. Accordingly, claim 1 is rejected.

Response to Arguments

6. Applicant's arguments filed have been fully considered but they are not persuasive.

- Applicant asserts that the Grasso reference meets neither of the claim requirements that both the mouthpiece and the holder be a single piece of molded plastic, nor that there be only two parts. The Examiner wishes to point out that independent claim 1 does not require that both the mouthpiece and holder be a single piece of plastic. Further, independent claim 14 merely requires that the holder and mouthpiece are each made from a single piece of molded plastic, which the Examiner believes has no patentably distinguishing characteristics that would define over the Grasso reference since whatever physical form of material an item is made from has no bearing on the final product.

- Applicant argues that the claimed invention uses two o-rings whereas Grasso uses only one o-ring and a seal in place of a second o-ring. However, since o-rings are so conventional in many arts it is not deemed that the "two o-ring" limitations distinguish the claims, patentably, from the reference. As stated in the above rejection, it would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized two o-rings since such devices are known as a means of reinforcing the integrity of the sealed chamber.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

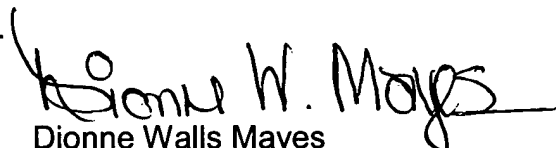
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Walls Mayes
Primary Examiner
Art Unit 1731

January 19, 2006